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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/224,918	01/04/99	HUNNICUTT H	1001/028C

EXAMINER	
EDELMAN, B	
ART UNIT	**PAPER NUMBER**
2153	

TM02/0130

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DATE MAILED: 01/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.	Applicant(s)
09/224,918	Hunnicutt et al.
Examiner	**Group Art Unit**
Bradley Edelman	2153

THE PERIOD FOR RESPONSE: [check only a) or b)]

a) [X] expires 3 / months from the mailing date of the final rejection.

b) [ ] expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

[ ] Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on *Jan 11, 2001* **has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:**

[ ] The proposed amendment(s):

[ ] will be entered upon filing of a Notice of Appeal and an Appeal Brief.

[ ] will not be entered because:

[ ] they raise new issues that would require further consideration and/or search. (See note below).

[ ] they raise the issue of new matter. (See note below).

[ ] they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

[ ] they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

[ ] Applicant's response has overcome the following rejection(s):

[ ] Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

[X] The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
It is not persuasive. See attached response.

[ ] The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

[X] For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: *none*

Claims objected to: *none*

Claims rejected: *1, 3-5, 7-15, and 17-33*

[ ] The proposed drawing correction filed on _____ [ ] has [ ] has not been approved by the Examiner.

[ ] Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____.

[ ] Other

ZARNI MAUNG
PRIMARY EXAMINER

DETAILED ACTION

This action is in response to Applicant's response after final filed on January 11, 2001. Claims 1, 3-5, 7-15, and 17-33 are presented for further examination.

Response to Arguments

In response to Applicant's request for reconsideration filed on January 11, 2001, the following factual arguments are noted:

a) In considering independent claims 1, 15, and 31, the claimed invention is not password-based and does not employ authentication handshaking between multiple network elements.

b) In further considering claims 1, 15, and 31, because the claims do not indicate the contrary, the computing device executing the claimed plurality of executable instructions fulfills each of the claimed elements (i.e. checking the memory for an indication of prior access, and providing the user access to the resource upon finding an indication of prior access in the memory).

c) In further considering claims 1, 15, and 31, Ensor cannot fairly be read as though the server (e.g., via the transaction manager 114) directly performs the required element of "checking a first memory".

d). In further considering claims 1, 15, and 31, Ensor requires authentication of every access, regardless of whether the user has previously accessed the resource, while the claimed invention eliminates the "handshaking" convention described by the Ensor reference.

e) In considering claims including the use of a token, insofar as a token is a grammatically indivisible element of a language, it would stand that it cannot then be parsed to examine "portions of the token". Therefore, checking a portion of a password is not translatable to the token space.

In considering (a), Applicant contends that in considering independent claims 1, 15, and 31, the claimed invention is not password-based and does not employ authentication handshaking between multiple network elements. Examiner respectfully disagrees. The invention claimed in the independent claims includes the following limitations:

I) checking a first memory to determine if a user has previously accessed a requested resource; and

II) providing the user with access to the resource if the first memory indicates that the user has previously accessed the resource.

The Ensor reference clearly discloses both of these limitations in the following passages:

I) A subscriber at a terminal device (110) requests connection to a service bureau (108) - col. 4, lines 40-50.

II) A first memory (126) is checked - col. 5, lines 8-12.

III) If a password is returned from the memory, and the password is authentic, the terminal has already been previously registered with the service bureau - col. 5, lines 54-58.

IV) After the password is returned from the memory, the terminal's request is fulfilled - col. 5, lines 32-35.

According to this process, the existence of a password in the memory signifies that the terminal has previously accessed the resource (i.e. registered with the service bureau), so long as the password has not been tampered with or otherwise altered (col. 5, lines 27-32, 60-66). Further, when the memory indicates that the user has gained previous access (i.e. a password exists in the memory), the user is provided access to the resource, so long as the password has not been tampered with or otherwise altered. Thus Ensor goes one step further than the claimed invention in not only describing that a memory is checked to determine of a user has previously accessed a resource, but also explaining *how* the checking of the memory determines whether a user has previously accessed a resource (i.e. checking for a stored password and/or including authentication). Although the claimed invention includes no mention of passwords or authentication, it also does not include specific steps describing how the memory is checked. The claimed invention also does not include specific steps describing how the memory is *not* checked. One cannot assume that any specific method of checking the memory (i.e. through the use of a password) is precluded unless it is described in the claims. Therefore, the claimed invention, as broadly interpreted, is anticipated by the Ensor reference, and claims 1, 15, and 31 remain rejected.

In considering (b), Applicant contends that in further considering claims 1, 15, and 31, because the claims do not indicate the contrary, the computing device executing the claimed plurality of executable instructions fulfills each of the claimed elements (i.e. checking the memory for an indication of prior access, and providing the user access to the resource upon finding an indication of prior access in the memory). Thus, since the prior art of record discloses separate computing devices performing the claimed steps, the present invention is patentable over the prior art. Examiner respectfully, and strongly disagrees. The claims *do not* state which device performs the steps of checking a memory and providing access. In fact, the claims to not even mention a "computing device". They merely mention a "computer readable medium", and a "method", comprising the steps of "checking...", and "providing...". Furthermore, just because a claim does not indicate the contrary to a limitation does not mean that the limitation is claimed. Therefore, for these reasons, claims 1, 15, and 31 remain rejected.

In considering (c), Applicant contends that in further considering claims 1, 15, and 31, Ensor cannot fairly be read as though the server (e.g., via the transaction manager 114) directly performs the required element of "checking a first memory". Examiner respectfully disagrees for similar reasons as discussed with respect to (b). Particularly, the claimed invention does not include the limitation that the *server* performs the steps of "checking a first memory". The claimed invention does not disclose which device performs the claimed steps. Therefore, whether or not Ensor discloses that limitation is moot.

In considering (d), Applicant contends that in further considering claims 1, 15, and 31, Ensor requires authentication of every access, regardless of whether the user has previously accessed the resource, while the claimed invention eliminates the "handshaking" convention described by the Ensor reference. Once again, Applicant's argument relies on limitations which are not claimed. The claimed invention does not cite the "elimination of handshaking". In fact, claims 1, 15, and 31 do not describe how the step of checking a memory determines whether a user has gained previous access to a resource. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In considering (e), Applicant contends that in considering claims including the use of a token, insofar as a token is a grammatically indivisible element of a language, it would stand that it cannot then be parsed to examine "portions of the token". Therefore, checking a portion of a password is not translatable to the token space. Examiner respectfully disagrees. Applicant defines a token as "a basic, grammatically indivisible unit of a language such as a keyword, operator or identifier." Applicant further states that a token may be represented as a password, as understood by Examiner (see p. 6, lines 13-14, which states that "applicant concedes that a token may well be represented as a *token*" - it is believed by Examiner that this was meant to read "applicant concedes that a token may well be represented as a *password*"). Thus, the portion of the password that the Ensor reference checks is in fact a "keyword, operator, or identifier," and it

represents the plurality of users, as claimed. Therefore, Ensor discloses the claimed token, and the claims which include the use of a token remain rejected.

Conclusion

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess, can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7201.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.

BE

January 29, 2001

ZARNI MAUNG
PRIMARY EXAMINER